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Paper No.

ARNOLD & PORTER
IP DOCKETING DEPARTMENT; RM 1126(b)
555 12TH STREET, N.W.
WASHINGTON DC 20004-1206

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OFFICE OF PETITIONS

| | | |
|----------------------------|---|-------------------|
| In re Application of | : | |
| Thomas G. Ruff, et al. | : | DECISION GRANTING |
| Application No. 09/849,526 | : | PETITION UNDER |
| Filed: May 7, 2001 | : | 37 CFR 1.137(b) |
| Atty. Docket No. 16517.250 | : | |
| [38-21 (51930)B | : | |

This is a decision on the petition, filed August 26, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. See 37 CFR 1.137(f).

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The petition is **GRANTED**.

The record discloses that, on May 7, 2001, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed certifying that "the invention disclosed in the attached **application has not and will not be** the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing."

Petitioner now indicates that the certification was improper since an international or foreign application corresponding to the instant application was filed on April 13, 2001, which date is prior to the date of filing of the instant application. Petitioner further states that the instant nonprovisional application became the subject of an application filed in a foreign country on December 4, 2002. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign country.

While petitioner should rescind any improper certification as soon as possible, 35 U.S.C. § 122(b)(2)(B)(i)-(iv) does not include any provision for "correction" of an improper certification. Consequently, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for a failure to timely notify the USPTO of a foreign or international filing within 45 days after December 4, 2002, the date of filing of such foreign or international application.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

- (1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
- (2) the petition fee as set forth in 37 CFR 1.17(m); and
- (3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application

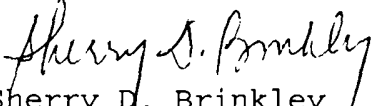
as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request indicating a projected publication date of February 12, 2004 accompanies this decision.

In view of the Petition for Express Abandonment Under 37 CFR 1.138(c) filed August 7, 2003, this application is being revived for the purposes of continuity only with the continuing applications purportedly filed April 28, 2003 and July 2, 2003, respectively.

The petition for express abandonment has been forwarded to the Office of Publication for appropriate consideration. Thereafter, this application will be processed by Technology Center AU 1637 as an abandoned application.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-9220.


Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|--------------------|---------------------|-----------------------|---------------------------|
| 09/849,526 | 05/07/2001 | Thomas G. Ruff | 16517.250 [38-21 (51930)B |

CONFIRMATION NO. 7991

28381
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OC000000011206668

Date Mailed: 11/06/2003

Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 02/12/2004.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"¹ then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (703) 305-9282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

¹ Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".